



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/757,644	01/11/2001	Yoshinobu Makino	2091-0228P-SP	8028

7590 01/13/2006

BIRCH, STEWART, KOLASCH & BIRCH, LLP  
P.O. BOX 747  
FALLS CHURCH, VA 22040-0747

EXAMINER

BARQADLE, YASIN M

ART UNIT PAPER NUMBER

2153

DATE MAILED: 01/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/757,644

Applicant(s)

MAKINO, YOSHINOBU

Examiner

Yasin M. Barqadle

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10/17/2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

Art Unit: 2153

**Response to Amendment**

The amendment filed on October 17, 2005 has been fully considered but are moot in view of the new ground(s) of rejection. Claims 1-14 are pending

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dane et al. (WO 99/19811, hereinafter "Dane") in view of Nakajima et al (US. Patent No. 6665083, hereinafter "Nakajima"). Dane discloses a networked computer system for viewing and ordering prints of **photographs**. Dane shows:

In referring to claim 1, Dane discloses *"a server computer is connected to the Internet, over which hosts, guests, **photographers**, and others associated with an event have access to the system for uploading photographic images, downloading photographic images, ordering prints, and transferring payment information"* (Dane, abstract). Dane, Figure 2 shows that the **output servers 20** (or **30**) obtain the material data from either server 10 or the **photographer 16**. The user 12 places the order through the server 10. The same argument applies to claims 6-9. Dane shows:

- At least one client for generating order information for ordering output of material data: *"Interactive access to this electronic proofbook allows users and guests to select images for physical prints 310"* (Dane, p. 6, lines 20-32)

See Dane, Fig. 3

- At least one output server for outputting the material data based on the order information:  
Dane, Fig. 2, element 20
- The order information including a pointer for **indicating** a storage location of the material data other than the output server or **output** servers:

Art Unit: 2153

*"The present invention provides a system which allows for transferal of **photographic images** from a number of **photographers** to a typically website based **photographic repository order server**"*  
(Dane, p. 2, lines 10-13)

- The output server obtaining the material data by accessing the storage location other than the **output** server based on the pointer included in the order information:

Dane, Fig. 2, the **output** server **20 obtains** the material data from the **photographers 16**

Although Dane shows substantial features of the claimed invention, he does not explicitly show a location storage location being in a personal computer

Nonetheless, this feature is well known in the art and would have been an obvious modification of the system disclosed by Dane, as evidenced by Nakajima USPN. (6665083).

In analogous art, Nakajima whose invention is about a recording medium for recording photograph print ordering information, discloses a preferable system "that a service provider provide its customers with personal computer application software or the like which can easily record the ordering information in a recording medium. A recording medium readable by a computer stores such a software program described above where by a computer executes processing of inputting information regarding an orderer of a printing order, inputting link information to image data to be printed, inputting information regarding the content of the printing order, describing the information regarding the orderer in an orderer stream, describing the link information in a link information stream, and describing processing regarding the content of the order in an order content stream (Col. 4, lines 41-54. See also col. 3 lines 46 to col. 4, line 30.

Giving the teaching of Nakajima, a person of ordinary skill in the art would have readily recognized the desirability and the advantage of modifying Dane by employing the system of Nakajima in order to have the flexibility of storing image data and related software

Art Unit: 2153

information at any location in the network, in this way services can be provided to customers more quickly.

In referring to claim 2,

- A relay server existing between at least one client and one output server: Dane, Fig. 2, shows a relay server 10 between the clients 18 and the **output** server 20

In referring to claim 3,

- The relay server comprises servers at a plurality of steps:  
Dane, Fig. 2, the relay server 10 connects to multiple servers, including **photographers 16, photo finishing lab 20, a bank 26, and a shipping facility 30**

In referring to claim 4,

**The order information is provided to the output server via a network: Dane, Fig. 2 shows that servers 10, 16, 20 and clients 18 are connected via a network)**

In referring to claim 6,

- **A computer readable recording medium storing order information for ordering output of material data:**

**Dane, Fig. 2, server 10 has a computer readable recording medium storing order information for ordering output of material data**

- **The order information including a pointer to obtain the material data:**

**A pointer to data is inherently implied in a system in which orders for prints of the data are sent to a server that does not have said data.**

Claims 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dane et al. (WO 99/19811, hereinafter "Dane") in view of Nakajima et al (US. Patent No. 6665083, hereinafter "Nakajima") and further in view of Arledge USPN. (6535294).

Art Unit: 2153

As per claims 10 and 11, although Dane and Nakajima show substantial features of the claimed invention, they do not explicitly show a location sending a receipt confirmation to at least one client.

Nonetheless, this feature is well known in the art and would have been an obvious modification of the system disclosed by Dane and Nakajima, as evidenced by Arledge USPN. (6535294).

In analogous art, Nakajima whose invention is about a system for preparing customized printed products over a communication network, sending a receipt confirmation to the at least one client "With combined reference to FIGS. 1 and 22, an e-mail message 145e is automatically transmitted from the wholesaler web server computer 140 to the retailer web server computer 120, notifying the retailer that a new order has been docketed on the retailer's new order queue. A copy of the new order is not transmitted to the retailer; rather, the notification simply instructs the retailer to connect to the wholesaler's web server computer 140, via the wholesaler's Internet web site, and to access the retailer's dealer account files thereon for information relating to the new order" (col. 19, lines 58-67). Giving the teaching of Arledge, a person of ordinary skill in the art would have readily recognized the desirability and the advantage of modifying Dane and Nakajima by employing the system of Arledge in order to assure customers that their order has been received and being processed.

As to claims 12-14, these claims have similar limitations found in claims 1 and 10-11; therefore, they are rejected with the same rationale.

Claims 1, 2, 4, and 6-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Hertling (U.S. Patent Number 6757741, hereinafter "Hertling"). Hertling discloses system and method for network printing using a peer hybrid printing protocol. Hertling shows:

Art Unit: 2153

In referring to claim 1,

- At least one client for generating order information for ordering output of material data: Hertling, Fig. 2 shows a client 106 for generating order information for ordering output of material data
- At least one output server for outputting the material data based on the order information: Hertling, Fig. 2 shows an output server 113 for outputting the material data based on the order information
- The order information including a pointer for indicating a storage location of the material data other than the output server or output servers; the output server obtaining the material data by accessing the storage location other than the output server based on the pointer included in the order information:

Hertling, Fig. 2 shows the print job ticket 303 is used to obtain the full print job 313 from client 106

In referring to claim 2,

A relay server existing between at least one client and one output server.

Hertling, Fig. 2 shows a relay server 109 in between the client 106 and the output server 113

In referring to claim 4,

The order information is provided to the output server via a network:

Hertling, Fig. 2 shows the order information 303 is provided to the output server 113 via network 103

In referring to claim 6,

- A computer readable recording medium storing order information for ordering output of material data; the order information including a pointer to obtain the material data:  
Hertling, Fig. 2, the job ticket 303 is stored on a computer readable recording medium at each of the computers **106,109,113**

In referring to claims 7, 8, and 9,

- Obtaining material data by accessing the storage **location based on** the pointer **included** in the order information:

Hertling, Fig. 2 shows the print job ticket **303** is used to obtain the full print job 313

- **Outputting the material data that have been obtained:**

**Hertling**, Fig. 2 shows **Print Server 113** outputs the material data on the Printer 116

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all **obviousness** rejections set forth in this Office action:

(a) A patent may not be **obtained though** the invention is not **identically disclosed or described** as set forth in section 102 of this title, if the **differences** between the subject matter sought to be patented and the prior art are **such that** the subject matter as a whole would have been **obvious** at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 5 is **rejected under** 35 U.S.C. 103(a) as **being unpatentable over Dane in view of** Fredlund et al. (U.S. Patent Number 5,666,215, hereinafter "Fredlund"). Although Dane shows substantial features of the claimed invention, Dane does not **show providing the order** information on a computer readable medium. Nonetheless this feature is *well known* in the art and would have been an obvious modification to the system disclosed by Dane as evidenced by Fredlund.

In analogous art, Fredlund discloses a system and method for remotely selecting photographic images. Fredlund shows: The order information is provided to the output server by being recorded in a recording medium: "*After the order is prepared, the customer communicates the order to the digital image center 134, either by sending a floppy disc 100 containing the order information to the digital image center, or by communicating the order information over a telecommunication link 40*" (Fredlund, col. 8, lines 51-56).

Given these teachings, a person of ordinary skill in the art would have readily recognized the desirability and advantages of modifying the system of Dane so as to allow orders to be



Art Unit: 2153

placed with a computer readable medium, such as taught by Fredlund, in order to allow clients without networking capabilities to be able to use the digital photograph ordering system.

### Conclusion

The prior made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yasin Barqadle whose telephone number is 571-272-3947. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Burgess can be reached on 571-272-3949. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or public PAIR system. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YB

Art Unit 2153



KRISNA LIM  
PRIMARY EXAMINER